

REMARKS

The present amendment is submitted in response to the Office Action dated July 14, 2003. In the Office Action, the Examiner rejected claims 109-115 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-39 of U.S. Patent No. 6,437,064 in view of Mehta et al. (5,358,792) or Hodgson, Jr. (5,206,075) and further in view of Newsome (4,457,960).

With respect to the rejection of the claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-39 of U.S. Patent No. 6,437,064 ("the '064 patent") in view of Mehta or Hodgson, Jr. and further in view of Newsome,, Applicants respectfully submit that the claims, as currently drafted, distinctly define the present invention from any of the art of record, taken singly or in combination, for the reasons that follow.

More specifically, the Examiner has argued that the conflicting claims are not patentably distinct from the '064 patent because both the '064 patent and the instant application "are directed to structures, which comprise a barrier layer and at least one layer made from a polymer made by a single-site catalyst." Office Action, para. 3, lines5-6. However, nothing is even remotely suggested by the '064 patent, Mehta, Hodgson, Jr., Newsome, or any other prior art, for the claims as presented herein.

More specifically, claims 109-115 define film structures generally having a plurality of layers wherein a first layer is a barrier material and a second layer comprises a blend of a polymer of ethylene and a C₃-C₂₀ alpha olefin formed by the polymerization reaction with a single site catalyst or a metallocene catalyst system and another polyethylene. Moreover, the other polyethylene in the blend may be either low density polyethylene, linear low density

polyethylene, or a second polymer of ethylene and an alpha olefin formed by the polymerization reaction with a single site catalyst or metallocene catalyst system.

Even assuming that one having ordinary skill in the art could have combined the references cited in the Office Action, the resultant combination lacks critical features positively recited in the claims. Specifically, the resultant combination of the cited prior art lacks the teaching of a blend of a polymer of ethylene and a C₃-C₂₀ alpha olefin formed by the polymerization reaction with a single site catalyst or a metallocene catalyst system and another polyethylene.

Even if the cited prior art did disclose each of the elements of the claims of the present application, one of ordinary skill in the art would never have been motivated to modify claims 32-39 of the '064 patent in the manner suggested by the Examiner in formulating the rejection under the judicially created doctrine of obviousness-type double patenting. The question under obviousness-type double patenting is whether the totality of the art, including the claims of the prior patent, would collectively suggest the claimed invention to one having ordinary skill in the art. The Court of Appeals for the Federal Circuit has stated that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Geiger*, 815 F.2d 686, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

Even if the disparate references supply all of the elements of the claims, it is insufficient that the prior art discloses the components of Applicants' structures, either separately or used in other combinations. A teaching, suggestion or incentive must exist to make the combination of the Applicants. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1988).

Applicants respectfully submit that the Examiner has failed to provide an incentive or motivation to combine claims 32-39 of the '064 patent with any of the other prior art references. The Board of Patent Appeals and Interferences has stated, "When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper. . . . Absent such reasons or incentives, the teachings of the references are not combinable." *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1790 (B.P.A.I. 1987).

Applicants further respectfully submit the Examiner has merely located various elements of the Applicants' claimed invention using the blueprint supplied by the Applicants in the claims. It is well-established that:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated the "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)). Applicants respectfully submit that the Examiner has engaged in impermissible hindsight reconstruction to arrive at the claimed invention.

With the analysis of the deficiencies of claims 32-39 of the '064 patent and the other prior art references in mind, as discussed above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Examiner as required under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully request the Examiner to withdraw the rejection to the claims under the judicially created doctrine of obviousness-type double patenting.

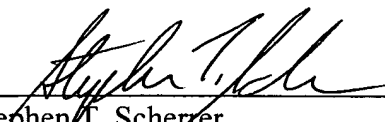
CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicants respectfully urge the Examiner to telephone the Applicants' attorney so that the same may be resolved and the application expedited to issue. Applicants respectfully request the Examiner to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

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